UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/802,589
Filing Date: March 17, 2004
Appellant(s): HAWKINS ET AL.

John L. Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08 May 2009 appealing from the Office

action mailed 15 April 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,243,725	Hempleman et al.	06-2001
US 7,209,942	Hori et al.	04-2007
US 2002/0042923	Asmussen et al.	04-2002

US 2002/0053078   Holtz   05-2002

US 2002/0152278   Pontenzone et al.   10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Appellant note: In the interest of expediency when writing the Final Rejection, the

grounds of rejection which had previously been set forth and which were neither argued

by Appellant nor overcome by amendment were incorporated by reference. For clarity,

the full grounds of rejection are reproduced herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Pontenzone et al. (Pub. No.: US2002/0152278) and further in view of Hori et

al. (US Pat. No.: 7,209,942).

As to claim 1, Pontenzone teaches a content delivery management system that

enables a user to create a customized playlist or internet radio station wherein:

> ...the content delivery management system comprises a database for storing information describing the content able to be delivered by one or more stations over the network...A user search module also preferably permits a user of the system to search the information stored in the database by a song name, artist name, or recording name...In yet another aspect, the content delivery

management system comprises a reporting module that compiles data based on song content delivered by each of the one or more stations, including data relating to the popularity of specific content with listeners of the stations. [0008-11]

Claim 1 further recites "at least one digital processor accessing the database and configured for communicating with a client device of a network." A digital processor is inherent in the system taught by Pontenzone since Pontenzone's system uses the Internet. As to the limitation that the system includes a database containing "heterogeneous multimedia content," Pontenzone teaches, *"...it will be readily appreciated that the system and method of the present invention can also be used to for other types of content, such as multimedia or video content"* [0026].

As to the amended limitation that the database contains demographic data, Pontenzone teaches the recited system but does not explicitly teach the recited demographic data. In an analogous art, Hori teaches a method for a search engine to suggest content to a user; Fig. 2D teaches that the system considers the user profile when searching the database, said profile including the recited demographic data. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system taught by Pontenzone with the user profile and preferences taught by Hori to provide users with content that they are more likely to purchase.

As to the amended limitation that

each playlist is uniquely associated with a respective consumer whose profile was used to generate the playlist; recalling a playlist for a respective consumer based on a consumer ID identifying the consumer; presenting, the playlist on a client device associated with the respective consumer; receiving at least one selection from the playlist; and processing the selection by transmitting to the client device a multimedia stream corresponding to the selection,

Pontenzone teaches that the system comprises a listener profile block 370 (see Fig.1) which allows users to create their own stations, each station comprising one or more playlists. The listener profile taught by Pontenzone is cumulative with the recited profile and consumer ID. That said playlist is "presented" on a client device and facilitates multimedia content to be transmitted to the user is inherent in Pontenzone, in that the Internet radio station of Pontenzone plays multimedia content in the order specified by a playlist (see, e.g., Fig. 2, 5, 8, 12, and para. 0066-67).

As to claim 2, the system taught by Pontenzone is intended to be used by any user with Internet access and a web-browser, thus the functionality of claims 2 and 4 are inherent in the system taught by Pontenzone.

Claim 4 recites the system of claim 1, wherein "the playlist is stored on the network, such that its consumer can share the playlist with other users on the network." Fig .1 of Pontenzone teaches a system comprising a database **400** and a station and playlist management module **235** which are accessible to a user through front end **300**. Pontenzone further teaches that the station and playlist module *"manages the content delivered by a number of stations over the network"* [ABST]. In light of system 100 and the fact that the content streamed over the network by Pontenzone is intended to be shared with users via the Internet, the recited functionality is inherent in the system of Pontenzone.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone et al. as applied to claim 1 above, and further in view of Asmussen et al. (Pub. No.: US2002/0042923) and Hempleman et al. (US Patent No.: 6,243,725).

As to claim 5, Pontenzone, as applied to claim 1, teaches a system to create a customized playlist comprising a database and processor, accessing a database containing "heterogeneous multimedia content" and generating a search vector, as recited.

As to the recited "accessing at least one database containing…third party marketing data, demographic data…" Pontenzone teaches, *"…the content delivery management system comprises a reporting module that compiles data based on song content delivered by each of the one or more stations, including data relating to the popularity of specific content with listeners of the stations"* [0011]. Data based on song content delivered by each station is the equivalent of the recited "third party marketing data." Given that Pontenzone's system allows for a plurality of listening stations which can be targeted to a specific market or genre, the preference of listeners of a various stations for specific content delivered by those stations can be reasonably interpreted as "demographic data."

As to the limitation, "wherein the logic comprises allowing a user to select a title from the playlist and if the metadata associated with the title indicates a billable event, billing the user for downloading content associated with the title" recited in claims 5 and 13, Pontenzone teaches a method wherein a user can request a song to be added to the database but does not explicitly teach a method for electronically purchasing said

requested content. Asmussen teaches a multimedia content suggestion engine, similar

to the search engine taught by Pontenzone in which metadata content associated with a

specific multimedia file may contain, *"...a program description, including program rating,*

program description, video clips, program length, format (e.g., 4.times.3 television or

16.times.9 movies), and other information; billing information and digital rights

management information" [0017]. Further, Hempleman teaches a system for creating a

playlist via a user-initiated search request, similar to that taught by Pontenzone. Fig. 6

of Hempleman teaches a "credit card input device" that facilitates the purchase of

multimedia content over a network. *"The unit 20 also supervisory and billing services in*

response to requests by the end user's unit 22 for access to one or more of the works

stored in the inventory in the databases 20b" (Col. 6, Lines 55-60). It would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the

purchasing functionality taught by Hempleman with the content request functionality

taught by Pontenzone to facilitate the purchase of requested content; likewise, it would

have been obvious to one of ordinary skill in the art to modify the metadata taught by

Pontenzone with the billing information taught by Asmussen to facilitate the purchasing

functionality taught by Hempleman.

As to the amended limitation of "<u>signifying whether all content in the playlist is</u>

<u>available for playback or is pending,</u>" Pontenzone teaches:

> A user (e.g., a music manager or a registered listener), associated with a
> playlist may view the playlist details and add songs to the playlist, provided the
> song has been properly encoded, i.e. is playable, in all required formats of the
> system. Blocks 250 and 530 may perform this playability validation on song
> recording data...As indicated, system 100 preferably only allows songs to be
> added to playlists if they are playable in each encoding format specified by

system 100. The playability of songs is verified by validation of data block 530 in data source application component 500. [0067, 0073]

The "playability validation" taught by Pontenzone which only allows "playable" songs (i.e., songs which have been converted to an acceptable file format) to be added to the user's playlist is cumulative with the recited "signifying."

As to claim 6, Fig. 6-7 of Hempleman teach methods for accepting payment from a user. Regarding keeping records of transactions, Hempleman teaches, *"[r]eport information can be transmitted to the system 20 for billing purposes...as well as making royalty payments to appropriate recipients"* (Col. 7, Line 34-39). The system (object **20**) is located remotely from the user and is connected to the terminal via an Internet connection, as shown in Fig. 6-7. As analyzed above the combination of Hempleman with Pontenzone would have been obvious to one of ordinary skill in the art at the time of the invention.

As to claim 7, Asmussen teaches a system which allows a user to search for multimedia content on a digital communication network and which tracks user data. Asmussen teaches, *"[a] user database server **511** maintains an aggregator user database **512**, which stores and processes information including, but not limited to, user account data, user profile information, user subscription services, user access rights, and past user search and download data (if authorized by the user)"* [0072]. It would have been obvious to one skilled in the art at the time of the invention to incorporate the user database server taught by Asmussen into the system taught by Pontenzone to provide better users of Pontenzone's system with increased access to available content.

Claims 8-12 and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pontenzone as applied to claim 1 above, and further in view of

Asmussen and Holtz et al. (Pub. No.: US 2002/0053078).

As to claim 8, Pontenzone teaches a method for generating a multimedia playlist

based on a user search and allows users to create user profiles or identities that are

stored on the network, but does not explicitly teach methods for archiving user search

history or for using such archives to generate search results. Asmussen teaches an

analogous method for searching content on a digital communications network, including

functionality to store user profile information comprising:

> user account type, user access level, and historical data. The user history
> analysis report is a summary of statistical analysis of the user's previous
> account activities that may include previous search requests, returned search
> results, and content download requests. [0078]

As to generating content suggestions based on the user profile data, paragraphs

0086 and 0116-117 of Holtz teach a system for generating content suggestions based

on user profile data. Specifically, paragraph 0086 of Holtz teaches:

> Each time enhanced media server 115 is accessed, data is captured and
> stored to develop a profile of the user. Every time the same enhanced media
> client 120 logs onto enhanced media server 115, enhanced media client 120
> receives a customized preprogrammed show according to the user's profile.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the playlist generation system of Pontenzone with the user profile

taught by Asmussen and the search method taught by Holtz to allow the system to

present users with profile-specific content suggestions in a manner cumulative the

claimed method.

Claim 9 recites the method of claim 8, "...without constraining the client device to be a particular single type of device." The playlist taught by Pontenzone is intended to be distributed to users via Internet radio. It is inherent that the playlist taught by Pontenzone can be accessed by users via more than one specific client device.

As to claim 10, both Pontenzone and Asmussen teach functionality for users to initiate a search.

As to claims 11 and 12, the recited functionality is inherent in the system taught by Pontenzone. Fig .1 of Pontenzone teaches a system comprising a database **400** and a station and playlist management module **235** which are accessible to a user through front end **300**. Pontenzone further teaches that the station and playlist module *"manages the content delivered by a number of stations over the network"* [ABST]. In light of system 100 and the fact that the content streamed over the network by Pontenzone is intended to be shared with users via the Internet, the recited functionality is inherent in the system of Pontenzone.

As to claim 15 Asmussen teaches that the system is capable of receiving a search request from a user and in paragraph 0078 (cited above) teaches that the system further stores past search requests.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone in view of Asmussen and Holtz as applied to claim 8 above, and further in view of Hempleman.

As to claim 13, Pontenzone in view of Asmussen and Holtz teaches the method of claim 8, but does not explicitly teach that the user can purchase a specific title from the playlist as claimed.   Asmussen teaches that a specific multimedia file may contain, *"...a program description, including program rating...billing information and digital rights management information"* [0017] but does not explicitly teach a mechanism for utilizing the billing data to purchase the specified content. Hempleman teaches an analogous system for creating a playlist via a user-initiated search request, similar to that taught by Pontenzone. Fig. 6 of Hempleman teaches a "credit card input device" that facilitates the purchase of multimedia content over a network. *"The unit 20 also supervisory and billing services in response to requests by the end user's unit 22 for access to one or more of the works stored in the inventory in the databases 20b"* (Col. 6, Lines 55-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the purchasing functionality taught by Hempleman with the content request functionality taught by Pontenzone to facilitate the purchase of requested content.

As to claim 14, Fig. 6-7 of Hempleman teach methods for accepting payment from a user. Regarding keeping records of transactions, Hempleman teaches that *"[r]eport information can be transmitted to the system 20 for billing purposes...as well as making royalty payments to appropriate recipients"* (Col. 7, Line 34-39). The system (object **20**) is located remotely from the user and is connected to the terminal via an Internet connection, as shown in Fig. 6-7.

(10) Response to Argument

Appellant's arguments filed 08 May 2009 have been fully considered but they are

not persuasive.

Examiner notes that on page 5 of the Appeal Brief, Appellant erroneously refers

to the rejection of claims 1, 2, and 4 as being anticipation rejections when, in fact, the

rejections of said claims are obviousness rejections under 35 U.S.C. 103.

Regarding claim 1, Appellant alleges that Pontenzone fails to teach the claimed

subject matter because:

> The songs on the playlist, but not the playlist itself, may be unicast or
> multicast, paragraph 27; the playlist, once established, is validated to ensure
> it meets certain rules and then the songs may be broadcast on a station,
> paragraph 63...an active playlist can't be edited, quite plainly meaning that a
> user cannot randomly select a random song from a playlist as desired...
> (Appeal Brief, pg. 5)

In response to Appellant's argument that the references fail to show certain

features of Appellant's invention, it is noted that the features upon which Appellant

relies, specifically unicasting or multicasting the playlist, editing a playlist, and "randomly

select[ing] a song" are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim 1 does not recite either unicasting or multicasting a playlist to a user as recited,

but merely "presenting the playlist on a client device associated with the respective

consumer, " which functionality is explicitly disclosed in Pontenzone:

> A user (e.g., a music manager or a registered listener), associated with a
> playlist may view the playlist details and add songs to the playlist, provided
> the song has been properly encoded, i.e. is playable, in all required formats of

the system...The playlist detail page preferably also contains a link to the
player application for each song on the playlist, so that a user can preview a
recording of a song when viewing the playlist details. [0067]

The Examiner maintains that allowing a user accessing the service of

Pontenzone at a client device connected to the Internet to view a playlist and add songs

to said playlist, as is taught by Pontenzone as cited above, is completely cumulative

with the recited limitation of "presenting the playlist on a client device associated with

the respective consumer." The Examiner reiterates, as stated above, that the alleged

"desired" functionality of "randomly select[ing] a random song" is not recited in any of

the currently pending claims.

As to Appellant's further allegations regarding claim 1:

> In addition or alternatively, because the allegedly "inherent" elements of
> recalling a playlist for a respective consumer based on a consumer ID
> identifying the consumer and then presenting the playlist on a client device
> associated with the respective consumer are not "necessarily" in Pontenzone,
> the rejection is clearly erroneous, (Appeal Brief, pg. 6)

the Examiner respectfully disagrees. Pontenzone teaches:

> System front end 300 generally runs on a Web server connected to the
> Internet (or other data distribution network) and thereby to listeners (or
> viewers in the case of video broadcast content) who receive the broadcast
> content. As shown in FIG. 1, front end 300 preferably includes the following
> operational blocks...a streaming music and meta data engine block 320
> which directs the trafficking of streaming broadcasts to listeners...[and] a
> playlist generator 350 which determines the order of broadcast content in
> accordance with prescribed system and licensing rules... [0030].

The Examiner maintains that the streaming of media content according to an

order specified by a playlist is completely cumulative with the recited limitations of

"receiving at least one selection from the playlist and processing the selection by

transmitting to the client device a multimedia stream corresponding to the selection." As

to Appellant's allegation that "Because…Pontenzone fails to teach at least two

limitations of claim 1, the rejection is clearly erroneous" (Appeal Brief, pg. 6), Examiner

maintains that Appellant's allegations are misplaced and that Pontenzone, as set forth

above, clearly anticipates the "at least two limitations" that Appellant mistakenly alleges

were not disclosed.

> With respect to claim 5, Appellant alleges:

>> Validating that a song on a playlist conforms to all required formats is not at
>> all a signal of whether a playlist is ready or incomplete, but rather merely an
>> indication as to whether any song in isolation has satisfied the validation
>> criteria. (Appeal Brief, pg. 6)

> The Examiner respectfully disagrees. As cited in the previous Office Action,

Pontenzone teaches that the system performs a validation check prior to allowing songs

to be added to a playlist. Specifically, Pontenzone teaches:

>> [the] system 100 preferably only allows songs to be added to playlists if they
>> are playable in each encoding format specified by system 100. The
>> playability of songs is verified by validation of data block 530 in data source
>> application component 500. For example, system 100 may require that all
>> songs be recorded in four different formats: a low bit rate RealPlayerTM
>> compatible format, a high bit rate RealPlayerTM compatible format, low bit
>> rate Windows Media PlayerTM compatible format, and a high bit rate
>> Windows Media PlayerTM compatible format. In this case, a song that is
>> properly encoded in all four of these formats, is playable in system 100.
>> [0073]

> The Examiner maintains that since Pontenzone performs said playability

validation for *each* content selection that is to be added to the playlist, the playability

validation taught by Pontenzone is equivalent to the recited "signifying whether all

content in the playlist is available for playback or is pending." That the system can

recognize that the content is properly encoded (and is therefore playable) is equivalent

to signifying that said content is available for playback. Further, one of ordinary skill in

the art at the time of the invention would appreciate that the fact that the system of

Pontenzone will *only* allow properly encoded content to be added to a playlist implies

that it will not allow improperly encoded content to be added to said playlist and

Examiner maintains that not allowing improperly encoded content to be added to a

playlist is equivalent to signifying that said content is incomplete.

With respect to claim 8, Appellant alleges:

> Independent Claim 8 continues to recite that the multimedia content is not
> constrained to be homogenous. The Office Action fails to mention this
> limitation and indeed, all of Pontenzone's playlist titles must be audio since
> they are broadcast over radio stations. Because this rejection fails to account
> for a claim limitation, and indeed because Pontenzone expressly teaches a
> system that requires its titles to be constrained to homogeneous audio
> content, the rejection is clear error. (Appeal Brief, pg. 6-7)

The Examiner respectfully disagrees. Pontenzone, as cited in the very first

Office Action issued in this case on 29 November 2007, explicitly teaches that *"...it will*

be readily appreciated that the system and method of the present invention can also be

used for other types of content, such as multimedia or video content" [0026]. In light of

Pontenzone's disclosure cited above, Appellant's argument that "Pontenzone expressly

teaches a system that requires its titles to be constrained to homogeneous audio

content" is clearly erroneous.

With respect to claims 9, 11, and 12, Appellant alleges:

> With particular regard to Claims 9, 11, and 12, the examiner once again relies
> on inherency without recognizing that Pontenzone may very well constrain the
> client device to be a particular single type of device (and thus not necessarily
> require Claim 9). The examiner also fails to recognize that Pontenzone
> simply plays songs from playlists, and that it consequently need not

"necessarily" allow the consumer to share the playlist with other users on the network (Claim 12).

The Examiner respectfully disagrees. With respect to claims 9 and 12, Pontenzone, as previously cited, teaches that the playlists stored at the server are intended to be accessed by a plurality of users via the Internet, such as through a World Wide Web page, such an interface inherently capable of being accessed by a plurality of client devices.

As to claim 11, Fig. 1 of Pontenzone explicitly teaches that the playlist is stored on the network.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ryan Stronczer/

Examiner, Art Unit 2425

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